REMARKS

Claim Rejections

Claims 1-5 are rejected under 35 U.S.C. § 112, second paragraph. Claims 2-5 are rejected under 35 U.S.C. § 112, first paragraph. Claim 1 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Nishihara (U.S. 5,561,712) and further in view of Parvulescu et al. (U.S. 5,802,460).

Drawings

The Examiner has objected to the drawings under 37 C.F.R. § 1.83(a) insofar as the house and terminal referred to in Applicant's claim 1, were not described in the specification. Since these terms have been deleted from Applicant's new claims, it is not believed that any drawing corrections are necessary.

It is noted that no Patent Drawing Review (Form PTO-948) was received with the outstanding Office Action. Thus, Applicant must assume that the drawings are acceptable as filed.

New Claims

By this Amendment, Applicant has canceled claims 1-5 and has added new claims 6-12 to this application. It is believed that the new claims specifically set forth each element of Applicant's invention in full compliance with 35 U.S.C. § 112, and define subject matter that is patentably distinguishable over the cited prior art, taken individually or in combination.

The new claims are directed toward a phone secretarial function extension device for a hand-free set (H) and a cellular phone (T) comprising: a freely portable remote controller (A) having: remote control unit (A1) located in the housing; and a man-to-machine interface (A81) controlling the remote control unit; an input/output interface (C) having a plurality of connection lines connected to a plurality of phone connection lines of a signal terminal (T1) of the cellular phone; and a receiver (B) connected to the hand-free set and the input/output interface, and having: remote control signals receiving and processing units (B2, B3); and a dialing controlling unit (B4) remotely controlled by the remote controller to send signals to the cellular

phone and selectively putting the cellular phone in a dialing status, wherein, when the man-to-machine interface is activated, the remote control unit transmits remote control signals to the receiver, the receiver receives the remote control signals, and the dialing controlling unit transmits dialing signals to the cellular phone and puts the cellular phone in the dialing status.

Other embodiments of the present invention include: the remote controller is a wireless remote controller; wherein the remote controller is a wired remote controller; the remote controller has: a power supply processing unit (A2) connected to an external power source; a light detecting and light transmitting control unit (A3); a dialing code unit (A6); a signal transmitting unit (A51); a signal transmission control unit (A5) connected to the dialing controlling unit and the signal transmitting unit and controlling the signal transmission unit; an AD/DA conversion unit (10); a man-to-machine interface control circuit (A8) connected to the man-to-machine interface; a digital signal processing unit (A7) connected to the AD/DA conversion unit; a microphone amplifying circuit (A9) connected to the AD/DA conversion unit; a microphone (M) connected to the microphone amplifying circuit; a speaker control and amplifying circuit (A11) connected to the AD/DA conversion unit; a speaker (S) connected to the speaker control and amplifying circuit; and a chief remote control unit (A1) connected to the power supply processing unit, the light detecting and light transmitting control unit, the dialing code unit, the man-to-machine interface control circuit, and the digital signal processing unit; the receiver has: a charging and power processing unit (B2) connected to the input/output interface; an infrared receiving unit (B3) receiving signals from a signal transmitting unit of the remote controller; a dual tone multiple frequency generator (B5); a communication detecting unit (B6); a first connection unit (B7) connected to the hand-free device; a second connection unit (B8) connected to the input/output interface; and a chief receiving control unit (B1) connected to the charging and power processing unit, the infrared receiving unit, the dual tone multiple frequency generator, the communication detecting unit, the first connection unit, and the second connection unit; the input/output interface has: a voice signal output line (C1) connected at a first end to the receiver and at a second end to the signal terminal of the cellular phone, and having an amplifier (OP1) and a capacitor (C11) serially connected thereto; a voice signal input line (C2)

connected at a first end to the receiver and at a second end to the signal terminal of the cellular phone, and having an amplifier (OP2) and a capacitor (C21) serially connected thereto; a charging line (C3) connected at a first end to the receiver and at a second end to the signal terminal of the cellular phone; a charging control circuit (D) connected to the charging line; a charging control line (C4) connected at a first end to the receiver and at a second end to the charging control circuit; a chief control unit (E); a dialing control line (C5) connected at a first end to the dialing controlling unit and at a second end to the chief control unit; a common dialing signal line (C6) connected at a first end to the dialing controlling unit and at a second end to the chief control unit; a flag pole control line (C7) connected at a first end to the receiver and at a second end to the chief control unit; a cellular phone working synchronic signal input line (C8) connected at a first end to the chief control unit and at a second end to the signal terminal of the cellular phone; and a cellular phone analog signal input line (C9) connected at a first end to the chief control unit and at a second end to the signal terminal of the cellular phone; and the input/output interface has: an AD conversion unit (Q); a programmable logic IC (L10); a shift temporary register (BF) connected to the AD conversion unit and the programmable logic IC; a voice signal output line (L1) connected at a first end to the receiver and at a second end to the AD conversion unit, and having an amplifier and a capacitor serially connected thereto; a voice signal input line (L2) connected at a first end to the receiver and at a second end to the AD conversion unit, and having an amplifier and a capacitor serially connected thereto; a charging line (L3) connected at a first end to the receiver and at a second end to the signal terminal of the cellular phone; a charging control circuit (D') connected to the charging line; a charging control line (L4) connected at a first end to the receiver and at a second end to the charging control circuit; a chief control unit (N2); a dialing control line (L5) connected at a first end to the dialing controlling unit and at a second end to the chief control unit; a common dialing signal line (L6) connected at a first end to the dialing controlling unit and at a second end to the chief control unit; a flag pole control line (L7) connected at a first end to the receiver and at a second end to the chief control unit; a cellular phone signal input line (L9) connected at a first end to the programmable logic IC and at a second end to the signal terminal of the cellular phone; and a shift control

line (L8) connected at a first end to the shift temporary register and at a second end to the signal terminal of the cellular phone.

The primary reference to Nishihara teaches a hands free phone set with a hand held remote control for controlling telephone functions including a main phone (100), a remote controller (200), and a data communication channel (300).

Nishihara does not teach a remote controller being a freely portable unit; the receiver having a dialing controlling unit remotely controlled by the remote controller to send signals to the cellular phone and selectively putting the cellular phone in a dialing status; nor does Nishihara teach when the man-to-machine interface is activated, the remote control unit transmits remote control signals to the receiver, the receiver receives the remote control signals, and the dialing controlling unit transmits dialing signals to the cellular phone and puts the cellular phone in the dialing status.

The secondary reference to Parvulescu et al. disclose a telephone hand set with a remote controller for transferring information to a wireless messaging device including a telephone hand set and remote controller apparatus (10) with a housing (11) that communicates with a wireless messaging device (20). Parvulescu et al. teach a telephone and a remote control device that are integrated together to communicate with a messaging device, whereas in the present invention the remote controller and the telephone are separate units and the remote controller communicates remotely through the receiver to the telephone.

Parvulescu et al. do not teach an input/output interface having a plurality of connection lines connected to a plurality of phone connection lines of a signal terminal of the cellular phone; a receiver connected to the hand-free set and the input/output interface; the receiver having a dialing controlling unit remotely controlled by the remote controller to send signals to the cellular phone and selectively putting the cellular phone in a dialing status; nor do Parvulescu et al. teach when the man-to-machine interface is activated, the remote control unit transmits remote control signals to the receiver, the receiver receives the remote control signals, and the dialing controlling unit transmits dialing signals to the cellular phone and puts the cellular phone in the dialing status.

Even if the teachings of Nishihara and Parvulescu et al. were combined, as suggested by the Examiner, the resultant combination does not suggest: the receiver having a dialing controlling unit remotely controlled by the remote controller to send signals to the cellular phone and selectively putting the cellular phone in a dialing status; nor does the combination suggest when the man-to-machine interface is activated, the remote control unit transmits remote control signals to the receiver, the receiver receives the remote control signals, and the dialing controlling unit transmits dialing signals to the cellular phone and puts the cellular phone in the dialing status.

It is a basic principle of U.S. patent law that it is improper to arbitrarily pick and choose prior art patents and combine selected portions of the selected patents on the basis of Applicant's disclosure to create a hypothetical combination which allegedly renders a claim obvious, unless there is some direction in the selected prior art patents to combine the selected teachings in a manner so as to negate the patentability of the claimed subject matter. This principle was enunciated over 40 years ago by the Court of Customs and Patent Appeals in In re Rothermel and Waddell, 125 USPQ 328 (CCPA 1960) wherein the court stated, at page 331:

> The examiner and the board in rejecting the appealed claims did so by what appears to us to be a piecemeal reconstruction of the prior art patents in the light of appellants' disclosure. ... It is easy now to attribute to this prior art the knowledge which was first made available by appellants and then to assume that it would have been obvious to one having the ordinary skill in the art to make these suggested reconstructions. While such a reconstruction of the art may be an alluring way to rationalize a rejection of the claims, it is not the type of rejection which the statute authorizes.

The same conclusion was later reached by the Court of Appeals for the Federal Circuit in Orthopedic Equipment Company Inc. v. United States, 217 USPQ 193 (Fed.Cir. 1983). In that decision, the court stated, at page 199:

> As has been previously explained, the available art shows each of the elements of the claims in suit. Armed with this information, would it then be non-obvious to this person of ordinary skill in the art to coordinate these elements in the same manner as the claims in suit? The difficulty which attaches to all honest attempts to answer this question can be attributed to the strong temptation to rely on hindsight while undertaking this evaluation. It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of non-obviousness in a court of law.

In In re Geiger, 2 USPQ2d, 1276 (Fed.Cir. 1987) the court stated, at page 1278:

> We agree with appellant that the PTO has failed to establish a *prima facie* case of obviousness. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination.

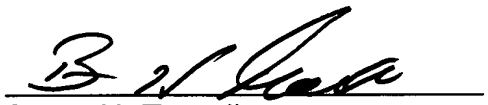
Applicant submits that there is not the slightest suggestion in either Nishihara or Parvulescu et al. that their respective teachings may be combined as suggested by the Examiner. Case law is clear that, absent any such teaching or suggestion in the prior art, such a combination cannot be made under 35 U.S.C. § 103.

Neither Nishihara nor Parvulescu et al. disclose, or suggest a modification of their specifically disclosed structures that would lead one having ordinary skill in the art to arrive at Applicant's claimed structure. Applicant hereby respectfully submits that no combination of the cited prior art renders obvious Applicant's new claims.

Summary

In view of the foregoing amendments and remarks, Applicant submits that this application is now in condition for allowance and such action is respectfully requested. Should any points remain in issue, which the Examiner feels could best be resolved by either a personal or a telephone interview, it is urged that Applicant's local attorney be contacted at the exchange listed below.

Respectfully submitted,

Date: November 5, 2004 By: 

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